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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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TRADEMARK TRIAL AND  
APPEAL BOARD

THE PEP BOYS MANNY, MOE & JACK )  
OF CALIFORNIA, )

Opposer, )

v. )

ALBINA FUEL COMPANY, )

Applicant. )

Opposition No. 125,016



07-10-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #34

**OPPOSER'S MOTION FOR DISCOVERY SANCTIONS**

COMES NOW the Opposer, The Pep Boys Manny, Moe & Jack of California [hereinafter "Pep Boys" or "Opposer"], through its undersigned counsel, pursuant to 37 C.F.R. §2.120(g)(2), and TBMP §527, and hereby moves for an Order from the Trademark Trial and Appeal Board (the "Board") sanctioning Applicant for failing to respond to written discovery and stating that no such response would be made.

On May 3, 2002, Opposer served on Applicant written discovery, namely Opposer's First Set of Interrogatories, Opposer's First Set of Document Requests and Opposer's First Set of Requests for Admissions. Applicant's responses were due to be served on or before June 7, 2002. *See* 37 C.F.R. §§2.120(a); 2.119(c). Applicant failed to timely respond, or to contact Opposer to request an extension of time prior to this expiration date. To date, Applicant's written responses have not been received by Opposer.

In fact, during a teleconference with Opposer's counsel, Applicant's counsel advised that Applicant would not be responding to Opposer's written discovery. *See* Gentner's June 25, 2002

letter to Klarquist, attached hereto as Exhibit A. Moreover, Applicant's counsel advised that Applicant did not intend to pursue the opposed Application or to defend the above-referenced opposition proceeding. *Id.* On June 25, 2002, Opposer's counsel sent, by facsimile and mail, a letter to Applicant's counsel outlining the substance of this conversation, including Applicant's intention to not respond to the written discovery. *Id.* Applicant's counsel was invited to correct any errors or misinterpretations in Opposer's counsel's June 25, 2002 letter immediately and in any case no later than **July 3, 2002**. *Id.* To date Applicant's counsel has not responded to Opposer's June 25, 2002 letter in any way or otherwise contacted Opposer's counsel.

The Rules expressly allow for the imposition of the sanction of judgment in a case where the non-responding party states that it will not respond to written discovery:

The motion for sanctions under 37 CFR 2.120(g)(2) is available only for discovery depositions, interrogatories, and requests for production of documents and things, and lies only where the responding party (1) has failed to respond, and (2) has informed the party seeking discovery that no response will be made. The sanctions which may be entered by the Board include, *inter alia*, . . . entering judgment against the disobedient party.

*See* TBMP §527.02. *See also* 37 CFR 2.120(g)(2) ("If a party . . . fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.").

However, this case is even more extreme than that contemplated by the Rule since Applicant's counsel affirmatively stated that Applicant did not intend to defend the Opposition

proceeding. This statement has been memorialized in writing to Applicant's counsel with an invitation to respond. Applicant's counsel has not contradicted the statements in that letter. At this point, anything short of entry of judgment against Applicant and for Opposer would be an unwarranted waste of the Board's judicial resources and Opposer's time, effort and resources.

### **Request for Suspension**

Since Opposer's Motion is arguably dispositive of the proceeding, Opposer assumes that the proceeding is suspended, pursuant to Trademark Rule 2.127(d) ("When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion . . ."). *See also* TBMP §510.03(a)(same). Additionally, pursuant to Rule 2.117(c), good cause exists for suspension of this proceeding in light of the fact that Opposer cannot prosecute this opposition without receiving written responses to Opposer's written discovery as well as Applicant's document production. Thus, to the extent that the proceeding is not automatically suspended, Opposer requests such suspension pending disposition of the present Motion.

WHEREFORE all of the foregoing reasons, Opposer respectfully requests that the Board suspend these proceedings while it considers the present Motion; and to ultimately grant its Motion for Sanctions and to enter judgment against Applicant and for Opposer.

Respectfully submitted,

THE PEP BOYS MANNY, MOE & JACK OF  
CALIFORNIA

By: 

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July 10, 2002

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on this 10<sup>th</sup> day of July, 2002, a true copy of the foregoing Opposer's Motion for Sanctions was served by first-class mail, postage prepaid, upon counsel for Applicant:

Kenneth S. Klarquist, Esquire  
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June 25, 2002

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*Via Facsimile*  
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*One (1) Page*  
*Confirmation Copy By Mail*

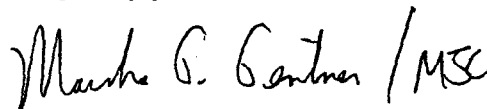
Re: Opposition No. 125,016  
PEP STOP & Design  
Serial No. 76/110,537  
Our Reference Number: 3701/I-4502

Dear Mr. Klarquist:

Please allow this correspondence to memorialize our recent telephone conversation wherein you indicated that your client does not intend to pursue the above-referenced Application or to defend the above-referenced Opposition proceeding, and that your client would not be responding to Opposer's written discovery, which was served on May 3, 2002. As you know, the date for Applicant to have responded to Opposer's written discovery is long past.

If letter misconstrues your statements to me during our telephone conversation, please advise immediately and in any case no later than July 3, 2002.

Very truly yours,



Marsha G. Gentner